

REMARKS

The Official Action mailed May 17, 2007, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes the *partial* consideration of the Information Disclosure Statement filed on March 22, 2007 (received by OIPE March 23, 2007). Specifically, it appears that the Examiner inadvertently overlooked the citation of the "Notification of Reason for Refusal dated November 29, 2005 for Application No. JP 2000-324364." The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the Notification of Reason for Refusal.

Claims 7-9 were pending in the present application prior to the above amendment. Claim 9 has been canceled without prejudice or disclaimer, and claims 7 and 8 have been amended to better recite the features of the present invention. Accordingly, claims 7 and 8 are now pending in the present application, both of which are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 7-9 under 35 U.S.C. § 112, first paragraph, asserting that "the newly amended 'so as to shift to an editing work' does not [have support] within the specification, however, the specification does indicate, 'the image processing unit generates an edit image for editing the title information' ..." (page 7, Paper No. 20070501). In response, in claims 7 and 8, "so as to shift to an editing work" has been changed to "so as to generate an edit image," which is consistent with the Examiner's comments and the present specification, and which is supported in the present specification, for example, by page 25, line 26, to page 26, line 1, and the step S38 in the flow chart shown in Figure 5. Therefore, the Applicant respectfully submits that amended claims 7 and 8 are adequately described and supported in the specification.

The Official Action rejects claims 7-9 under 35 U.S.C. § 112, second paragraph, asserting a lack of antecedent basis for "the title information" in lines 21-23. The Applicant respectfully disagrees and traverses the assertions in the Official Action. The term "title information" is positively recited in claims 7 and 8, at line 26. Therefore, the Applicant respectfully submits that claims 7 and 8 are definite.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 7-9 as obvious based on the combination of U.S. Patent No. 6,594,740 to Fukuda and pages 2-4 of the present specification, which the Official Action refers to as "Applicant Admitted Prior Art (AAPA - Background Information)." The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 7 and 8 have been amended to recite the following:

(a) It is judged whether a target reproduction disk has text information. Then, (i) if the target reproduction disk has any text information, then that text information is transferred to a control apparatus, and (ii) otherwise, disk information of the target reproduction disk is acquired from an external information management server.

(b) It is judged whether the text information is information of claiming a copyright. Then, (i) if the text information does not include information of claiming a copyright, then title information is extracted from the text information, and (ii) otherwise, a title area in a memory within the control apparatus is initialized for an editing process.

These features are supported in the present specification, for example, by page 24, line 6, to page 25, line 24, and the flow chart shown in Figure 5.

For the reasons provided below, Fukuda and AAPA, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

Fukuda and AAPA do not teach or suggest that two types of judgment processing (as to whether a target reproduction disk has text information and whether the text information is information of claiming a copyright) are performed.

Also, the Official Action continues to concede that "Fukuda did not expressly indicate the means for judging whether or not a track change has [occurred] to decide the completion of the recording of one piece of music" (page 6, Paper No. 20061204; and page 11, Paper No. 20070501). The Official Action continues to assert that AAPA teaches these features at page 2, lines 24-25 (Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Page 2, lines 24-25, of the present specification appears to disclose the following: "This title information registration process starts, for example, when music data is completely recorded from CD to MD" (emphasis added). That is, the process described at pages 2-4 is related to the completion of the recording of a complete CD to MD and does not relate to "the recording of one piece of music" as presently claimed and defined in the present specification.

In the "Response to Arguments" section, the Official Action asserts that "[the] CD is considered to be one piece of music" and that "[the] CD can contain one or more piece of music within the CD" (page 4, Paper No. 20070501). For the sake of argument, even if one were to consider a complete CD as "one piece of music," the Official Action still has not shown means for judging whether or not a track change has occurred to decide completion of the complete CD. No such teaching appears in Fukuda or the AAPA.

Therefore, the Applicant respectfully submits that Fukuda and AAPA, either alone or in combination, do not teach or suggest the features (a) and (b) noted above or means for judging whether or not a track change has occurred to decide completion of the recording of one piece of music.

Since Fukuda and AAPA do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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